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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Atty. Docket

Janice L. Jones

US040138US

Int'l Appln. No.: PCT/IB2005/050927

Int'l File Date: 03/16/2005

Title: DEFIBRILLATION ELECTRODE HAVING DRUG
DELIVERY CAPABILITY

Commissioner for Patents
P.O. Box 1450
Arlington, VA 22313-1450

PETITION WHEN INVENTOR REFUSES TO SIGN DECLARATION

Sir:

It is respectfully requested that the Commissioner permit the filing of this application with a Declaration signed by one of the two co-inventors, David E. Snyder, when the other co-inventor, Janice L. Jones, refuses to sign the Declaration. The underlying facts are as follows.

1. On July 1, 1999 Janice L. Jones entered into a Consulting Agreement with Hewlett-Packard Company (HP), the predecessor to the assignee of David E. Snyder, Philips Electronics. A copy of this Consulting Agreement is attached hereto. Under paragraph 5 of the Consulting Agreement, Dr. Jones agreed to disclose promptly any inventions made by her during the term of the Agreement. Paragraph 5 also provides that inventions developed jointly from joint contributions by HP (in the person of David E. Snyder) and Dr. Jones shall be owned jointly by Dr. Jones and HP. The present invention was developed jointly by Mr. Snyder and Dr. Jones under this Consulting Agreement.

2. A provisional application covering the present invention, serial no. 60/556,220 was filed on March 25, 2004. The form of the provisional application was

subsequently used for a PCT filing and for the present application in the national stage of the PCT filing.

3. On May 18, 2004 Philips Medical Systems, successor to HP by acquisition of the HP business, notified Dr. Jones that the July 1, 1999 Consulting Agreement was being terminated. A copy of the termination letter is attached hereto.

4. On May 6, 2004 the undersigned, attorney for Philips Medical Systems, sent the attached letter to Dr. Jones. This letter enclosed a Declaration form for Dr. Jones to sign. Dr. Jones never returned the Declaration.

5. On August 31, 2006 the undersigned sent another letter and Declaration form to the last known address of Dr. Jones for signing, a copy of which is enclosed. This letter was sent by return receipt postcard, a copy of which is enclosed. This postcard was signed upon delivery of the letter and returned to the undersigned. Dr. Jones has not returned this Declaration, either.

6. Should Dr. Jones return the signed Declaration it will be promptly filed in this application. In the meantime, it is respectfully requested that this application be allowed to proceed with the Declaration signed only by co-inventor David E. Snyder.

7. Please charge Deposit Account no. 14-1270 for the petition fee required by 37 CFR §1.17(g).

Respectfully submitted,

By: /W. Brinton Yorks, Jr./
W. Brinton Yorks, Jr.
Reg. No. 28,923

Philips Electronics
22100 Bothell Everett Highway
P.O. Box 3003
Bothell, WA 98041-3003
(425) 487-7152
September 18, 2006

Hewlett-Packard Company
Hearstroom operation
2401 Fourth Avenue, Suite 300
Seattle, Washington 98121-1436
208/684-7881



CONSULTING AGREEMENT

This Agreement is made effective July 1, 1999, by and between Hewlett-Packard Company, a Delaware corporation ("HP"), and DR. JANICE JONES, 24110 Clarksburg Road, Clarksburg, MD 20871 ("Dr. Jones").

In consideration of the mutual covenants and promises set forth herein, the parties hereby agree as follows:

1. Engagement. HP hereby retains the services of Dr. Jones and Dr. Jones agrees to render services as a consultant for HP in the areas of cardiology and defibrillation.
2. Term. This Agreement shall have an initial term of one (1) year, and shall continue thereafter year-to-year, unless terminated as provided for in Paragraph 6.
3. Duties. Dr. Jones shall consult with HP as requested in areas related to cardiology, cardiac pacing, and defibrillation. Dr. Jones agrees to make herself available for consulting with HP on miscellaneous matters in person in Washington, D.C. or Seattle, Washington, at such other locations as may be mutually convenient, or over the telephone, for at least three (3) days per quarter. As part of her consulting services, Dr. Jones agrees to attend special research group meetings with other investigators in Seattle or other places outside Washington, D.C., up to four (4) times per year. The group meetings may last up to two (2) days each.
4. Compensation. HP shall pay Dr. Jones thirty four thousand Dollars (\$34,000) per year, payable in four equal quarterly amounts of eight thousand five hundred Dollars (\$8,500), for the consulting services rendered pursuant to Section 3. Such quarterly payments shall be made by the fifteenth day of each quarter for services rendered during the current quarter. Travel expenses to and from all HP meetings shall be paid by HP. Travel expenses include all reasonable expenses incurred traveling to and from an event and all reasonable expenses, such as meals and lodging, incurred while at the event. Dr. Jones shall provide HP with appropriate documentation for tax purposes of all expenses paid by HP.
5. Intellectual Property
 - a. Ownership of Inventions: Dr. Jones agrees to disclose promptly to HP any inventions or improvements made or conceived by her or corporations controlled by her or her agents, either alone or jointly with others, during the term of this Agreement or within six (6) months thereafter that relate to consulting work performed for HP. Dr. Jones warrants

Hewlett-Packard Company
Heartstream Operations
2401 Fourth Avenue, Suite 300
Seattle, Washington 98121-1436
206/664-7630



that she does not have any commitments to others under which she is obligated to assign to such others inventions or improvements or rights therein, in conflict with its obligations to HP hereunder. Inventions, discoveries, technologies or enhancements developed during the course of this consultantship arising solely from HP's contribution shall belong to HP. Inventions, discoveries, technologies or enhancements developed jointly and arising from joint contribution of HP and Dr. Jones shall be owned jointly by Dr. Jones and HP. Inventions, discoveries, technologies developed by Dr. Jones during the consultantship arising solely from Dr. Jones' contribution shall belong to Dr. Jones.

b. Option to Acquire Inventions and Patents. Dr. Jones hereby grants HP an option to acquire an exclusive license for the use of Dr. Jones' patent rights relating to inventions, discoveries, technologies or enhancements relating to consulting work performed for HP that are made solely by Dr. Jones or jointly by Dr. Jones and HP. Dr. Jones and HP shall negotiate in good faith the terms of the license. If in eighteen (18) months from the later of i) the date of this Agreement or ii) the date the invention or patent disclosure is made to HP, Dr. Jones receives a bona fide offer from a third party for a license on such patent rights, Dr. Jones shall notify HP of the terms of the offer and give HP ninety (90) days to meet the terms of such offer. If HP does not meet the terms of such offer within such period, Dr. Jones shall be free to license the patents to the third party upon those terms.

6. Termination. This Agreement may be terminated at any time by either party, with or without cause, by giving the other party one hundred twenty (120) days written notice of intention to terminate.

7. Non Employee Status. Dr. Jones is to be retained as a consultant and not as an employee of HP. Dr. Jones shall be solely responsible for any employment-related taxes, insurance premiums or other employment benefits or expenses respecting the Contractor's performance of services under this Agreement.

8. Authority. Dr. Jones shall not have any right to bind HP or commit HP to any agreement or understanding whatsoever.

9. Exclusive Agreement. Because of the confidential nature of the information that might be disclosed to Dr. Jones, Dr. Jones will not during the term of this Agreement become a consultant for any other company that manufactures or sells transthoracic defibrillators.

10. Confidential Information. HP and Dr. Jones agree to abide by the terms of the Confidential Disclosure Agreement executed concurrently with the Agreement and attached hereto.

Hewlett-Packard Company
Heartstream Operation
2401 Fourth Avenue, Suite 300
Seattle, Washington 98121-1438
206/664-7630



11. Notices. All notices required or permitted by this Agreement shall be in writing and shall be delivered in person or sent by certified or registered mail, return receipt requested, postage prepaid, as follows:

HP:

Brad Gliner, Hewlett-Packard Co., Heartstream Operation, 2401 4th Ave.,
Suite 500, Seattle, WA 98121

Dr. Jones:

Janice Jones, Ph.D., 24110 Clarksburg Road Clarksburg, MD 20871

or to such other address as either party may designate in writing to the other.
All mailed notices shall be deemed effective upon being deposited in the mail.

12. Waiver. The waiver by either party of a breach of this Agreement shall not operate as or be construed as a continuing waiver or as a consent to or waiver of any subsequent breach.

13. Modification. This Agreement may only be modified in writing signed by both of the parties hereto.

14. Non-Assignable. Since the services to be provided under this Agreement are personal, all duties to be executed by Dr. Jones shall be performed by Dr. Jones and may not be assigned or delegated without written consent of HP.

15. Entire Agreement. This Agreement constitutes the entire agreement between the parties with respect to the subject matter hereof and supersedes all previous agreements and understandings whether oral or written between the parties with respect to the subject matter hereof.

16. Governing Law. This Agreement shall be interpreted under the laws of the State of Washington. Any dispute arising under this Agreement shall be heard in the courts of that state.

IN WITNESS WHEREOF, the parties have executed this Agreement effective the date first mentioned above.

Hewlett-Packard Company
Heartstream Operation
2401 Fourth Avenue, Suite 300
Seattle, Washington 98121-1436
206/664-7630



HEWLETT-PACKARD COMPANY

JANICE JONES, Ph.D.

By: Brad Gliner

Print Name: BRAD GLINER

Title: Research Director

Date: 6/10/99

By: Janice Jones

Date: 7/6/99



PHILIPS

Philips Medical Systems

Janice L. Jones, Ph.D.
24110 Clarksburg Road
Clarksburg, MD 20871

Heartstream Research

Tel: 206 664-2038
Fax: 206 664-2070

Re: Termination of Consulting Agreement

Date: May 18, 2004

Dear Dr. Jones,

On July 1, 1999 you entered into a Consulting Agreement with the Hewlett-Packard Company (copy attached), which provided (paragraph 2, Term) for year-to-year continuation of the agreement until termination by either party upon sufficient notice (paragraph 6, Termination). This agreement has followed the Heartstream organization through its various corporate changes, most recently being extended as an agreement with Philips Medical Systems.

As you and I have recently discussed and mutually agreed, it is now time to terminate this agreement. The operative extension of the agreement authorizes a final payment on August 13, 2004. This will be the final payment under the agreement.

On behalf of Heartstream, I want to thank you for your contributions to an extended, fruitful and stimulating relationship.

Sincerely,

A handwritten signature in cursive script that reads 'James K. Russell'.

James K. Russell, Ph.D.
Director of Research
Philips Medical Systems - Seattle
2301 5th Ave., Suite 200
Seattle, WA 98121



PHILIPS

Philips Intellectual Property & Standards

May 6, 2004

Dr. Janice L. Jones
24110 Clarksburg Road
Clarksburg, Maryland 20871

Re: Patent Application on Drug Delivery Defibrillator

Dear Dr. Jones:

As per my recent email and your exchange with David Snyder I enclose the forms that need to be filed as a consequence of your patent application filing which I did for you and David in March.

A US patent application has four required parts: a specification, one or more claims, drawings, and a declaration. The filing I made last month, a copy of which is enclosed, includes the first three. Enclosed with this letter for your signature is the Declaration form. I enclose two versions of this form. One is called a Declaration and Power of Attorney, and it is used if the patent application is filed only in the US. The other is a PCT form for the same purpose, which is used if the patent application is to be filed in other countries. Since I do not have the decision on foreign filing at this time I am asking you to please sign and date both. I will use only one of them at the appropriate time.

The purpose of the Declaration is to tell the US patent office that you are an inventor in the application, that you have reviewed the application (please do so), and that you acknowledge a duty to disclose information which is relevant to the examination of the patent application (prior art). You can do the latter through me. If you become aware of any prior art that predates April, 2004

please let me know and I will send it in to the patent office.

The patent application number referenced on the Declaration form is the one given by the patent office to the filing I made in March.

The third form is a Power of Attorney form for a PCT filing, by which you authorize me to do the processing of the patent application. In the first form the power of attorney is built into the declaration, but for the PCT the forms are separate.

Please sign and date these forms and send them back to me in the enclosed envelope. If you have any questions please call me at (425) 487-7152. I thank you for your assistance in this matter.

Sincerely yours,

A handwritten signature in cursive script, appearing to read "B. Yorks".

W. Brinton Yorks, Jr.
Principal Attorney

cc: David Snyder



PHILIPS

Philips Intellectual Property & Standards

August 31, 2006

RETURN RECEIPT REQUESTED

Dr. Janice L. Jones
24110 Clarksburg Road
Clarksburg, Maryland 20871

Re: Patent Application on Drug Delivery Defibrillator

Dear Dr. Jones:

The US Patent Office is now asking for the Declaration form for the patent application I filed for you and David Snyder on defibrillator drug delivery. Enclosed please find a copy of the form. Would you please sign and date the form and return it to me in the enclosed postage-paid envelope? I also enclose a copy of the patent application for your reference.

I have now received the search report on the patent application which cites a number of earlier patents on defibrillator drug delivery. Other people have done very similar things before and the patent we obtain will be narrower in scope than we had initially thought.

I thank you for your assistance with the patent application form. If you have any questions please call me at (425) 487-7152.

Sincerely yours,

W. Brinton Yorks, Jr.
Principal Attorney

DECLARATION AND POWER OF ATTORNEY
FOR PATENT APPLICATION

As a below named inventor(s), I/we hereby declare that:
My residence, post office address and citizenship are as stated below
next to my name;

I believe I am the original, first and sole inventor (if only one name
is listed below) or an original, first and joint inventor (if plural
names are listed below) of the subject matter which is claimed and for
which a patent is sought on the invention entitled

DEFIBRILLATION ELECTRODE HAVING DRUG DELIVERY CAPABILITY

the specification of which(check one)

☒ [X] is attached hereto

☐ [] was filed on _____ as Application Serial No.
_____.

I hereby state that I have reviewed and understand the contents of the
above-identified specification, including the claims, as amended by
any amendment referred to above.

I acknowledge the duty to disclose information which is material to
the examination of this application in accordance with Title 37, Code
of Federal Regulations, §1.56(a).

I hereby claim the benefit under Title 35, United States Code, §120 of
any United States application(s) listed below and, insofar as the
subject matter of each of the claims of this application is not
disclosed in the prior United States application in the manner
provided by the first paragraph of Title 35, United States Code, §112,
I acknowledge the duty to disclose material information as defined in
Title 37, Code of Federal Regulations, §1.56(a) which occurred between
the filing date of the prior application and the national or PCT
international filing date of this application:

60/556,220
Application Serial No.

03/25/2004
Filing Date

Status

I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith as well as to file equivalent patent applications in countries foreign to the United States including the filing of international patent applications in accordance with the Patent Cooperation Treaty: W. Brinton Yorks, Jr. (Reg. #28,923), Frederick J. McKinnon (Reg. #28,240), Jack E. Haken (Reg. #26902), and Michael E. Marion (Reg. #32,266).

Address all telephone calls to W. Brinton Yorks, Jr. at
telephone no. (425) 487-7152.

Address all correspondence to W. Brinton Yorks, Jr., ATL Ultrasound,
Inc., 22100 Bothell Everett Highway, P.O. Box 3003, Bothell,
Washington 98041-3003.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Inventor's Signature: _____

Full Name of First Inventor:

Janice L. Jones

Date: _____

Citizenship: United States

Residence City: Clarksbury, MD

Post Office Address: P. O. Box 3003, Bothell, WA 98041-3003, USA

Inventor's Signature: _____

Full Name of Second Inventor:

David E. Snyder

Date: _____

Citizenship: United States

Residence City: Bainbridge Island, WA

Post Office Address: P. O. Box 3003, Bothell, WA 98041-3003, USA

US040138

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- Complete items 3, 4a, and 4b.
- Print your name and address on the reverse of this form so that we can return this card to you.
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Consult postmaster for fee.

3. Article Addressed to:

Dr. Janice L. Jones
24110 Clarksburg Road
Clarksburg, MD 20871

4a. Article Number

7099 3400 0014 5308 2858

4b. Service Type

- ☐ Registered ☒ Certified
☐ Express Mail ☐ Insured
☒ Return Receipt for Merchandise ☐ COD

7. Date of Delivery

5. Received by: (Print Name)

Janice Moore

6. Signature: (Addressee or Agent)

X

Janice Moore

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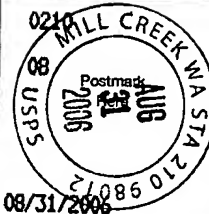
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CLARKSBURG MD 20871

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Restricted Delivery Fee (Endorsement Required)		\$0.00
Total Postage & Fees	\$	\$5.60



Recipient's Name (Please Print Clearly) (to be completed by mailer)

Dr. Janice L. Jones

Street, Apt. No., or PO Box No.

24110 Clarksburg Road

City, State, ZIP+4

Clarksburg, MD 20871

PS Form 3800, February 2000

See Reverse for Instructions

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J. PEISTRUP

Ms. Jill Peistrup
Sr. Legal Assistant
Philips Intellectual Property & Standards
P. O. Box 3003
Bothell, WA 98041-3003

03 8500



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